



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/707,715

01/06/2004

Karen Aviles

03292.101820.

1714

66569 7590 01/08/2009  
FITZPATRICK CELLA (AMEX)  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

LONG, FONYA M

ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

01/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/707,715	<b>Applicant(s)</b> AVILES ET AL.	
	<b>Examiner</b> FONYA LONG	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This communication is a second Office Action Non-Final rejection on the merits. Claims 1-7, 10, 15, 16, and 20 have been amended. Claims 1-20 are currently pending and have been addressed below.

#### ***Response to Amendment***

1. Applicant's amendments to the claims are sufficient enough to overcome the 112 2nd rejection set forth in the previous office action.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 1-20, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4-7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over DonationDepot.com (October 08, 2001) in view of MacFarlane et al. (7,014,104).

**As per Claims 1, 2, 4-7, and 9**, DonationDepot.com discloses a donation method, which is located in an online environment (via DonationDepot.com website) that is configured to facilitate:

providing access to all government approved 501(c) charities (Pages 1 and 3, discloses the system being provided for all donors and all US 501(c) 3 non-profit organizations, wherein a list of all registered non-profit organizations in the United States are provided to the donors) via a donation portal (defined as a site serving as a guide or point of entry to the World Wide Web and usually including a search engine or a collection of links to other sites arranged especially by topic in *Merriam-Webster Online Dictionary*. Retrieved July 17, 2008, from <http://www.merriawebster.com/dictionary/portal>) (Pages 1-10, discloses providing a search engine on the website where a donor may search for a charity; and providing a hyperlink to obtain additional information about a charity via "Featured Charity");

searching for at least one of said charities (Page 1, discloses a donor capable of searching for a charity via “Find a Charity”); and

receiving donation information including recurring billing information (Page 2, discloses receiving automatic payroll deduction information (i.e. recurring billing)), donor information (Page 5, discloses the donor providing personal information such as name, address, and phone), donation amount (Page 6, discloses the donor providing the amount to be donated), and gift matching information (Pages 4 and 6, discloses the donor providing company gift matching information).

However, DonationDepot.com fails to explicitly disclose receiving data from the employee and verifying the donation information.

MacFarlane et al. discloses a gift matching method with the concept of receiving data from the employee indicating that the employer: will gift match at least a portion of the donation amount; and should be granted access rights to verify the donation information (Abstract, discloses receiving information indicating the gift matching amount being provided by the gift matcher);

verifying the donation information on behalf of the employer by, at least: confirming a payment from the employer for the donation amount was processed (Fig. 6A, discloses confirming a payment via confirming transfer has cleared); verifying that the charity selected by the employer is a government approved charity by, at least, searching at least one of an Internal Revenue Service (IRS) database and a third-party database of government approved charities (Col. 9, Lines 11-35, discloses determining whether the charity qualifies in the United States as a charity); and generating a receipt

Art Unit: 3689

for the employer by, at least: searching gift matching forms specific to the employer; selecting a particular form based, at least in part, on the charity selected by the employee; completing the selected gift matching form specific to the employer based on the donation information; and forwarding the completed form to the employer; and activating, after the verifying, a gift matching payment on behalf of the employer (Col. 8, Line 50-67, discloses providing a tax receipt to a matching party wherein matching forms are selected and completed by initiators).

Therefore, from the teaching of MacFarlane et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system for conducting donations of DonationDepot.com to include receiving data from the employee and verifying the donation information as taught by MacFarlane et al. in order to aid provide a convenient means to donate to charitable organizations electronically.

Examiner asserts the fact that the employee submits donation information and the data received indicates that the employee will gift match and should be granted access rights in considered non-functional descriptive material. The person submitting donation information being an employee and the type of data being received does not change the function of the claimed invention. Examiner asserts the DonationDepot.com and MacFarlane et al. combination is fully capable of the employee submitting donation information and the data received indicating that the employee will gift match and should be granted access rights in considered non-functional descriptive material.

Art Unit: 3689

6. Claims 3, 8, and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DonationDepot.com (October 08, 2001) in view of MacFarlane et al. (7,014,104) and in further view of Chien et al. (US 2001/0054003).

**As per Claims 3 and 8**, the DonationDepot.com and MacFarlane combination discloses the claimed invention as applied to Claim 1, above. However, the combination fails to explicitly disclose loyalty points being used as a charitable donation.

Chien et al. discloses a system and method of using loyalty points with the concept of loyalty points being used as a charitable donation ([0012] discloses a user redeeming or converting loyalty points for charitable donations).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the DonationDepot.com and MacFarlane combination to include loyalty points being used as a charitable donation as taught by Chien et al. in order to provide a non-monetary way for a donor to contribute to a desired charitable organization.

**As per Claims 10-20**, DonationDepot.com discloses a donation method, wherein said method comprising:

accessing at least one of all government approved 501(c) charities (Pages 1 and 3, discloses the system being provided for all donors and all US 501(c) 3 non-profit organizations, wherein a list of all registered non-profit organizations in the United States are provided to the donors) via a donation portal (defined as a site serving as a guide or point of entry to the World Wide Web and usually including a search engine or a collection of links to other sites arranged especially by topic in *Merriam-Webster*

Art Unit: 3689

*Online Dictionary*. Retrieved July 17, 2008, from

<http://www.merriawebster.com/dictionary/portal>) (Pages 1-10, discloses providing a search engine on the website where a donor may search for a charity; and providing a hyperlink to obtain additional information about a charity via "Featured Charity") by providing at least one list capabilities, searching capabilities, and selecting capabilities (Page 1, discloses a donor being able to search for a charity, or obtain a listing of charities); and

receiving donation information for at least one of said charities, wherein donation information includes donor information (Page 5, discloses the donor providing personal information such as name, address, and phone), donation amount (Page 6, discloses the donor providing the amount to be donated), recurring billing information (Page 2, discloses receiving automatic payroll deduction information (i.e. recurring billing)), and gift matching information (Pages 4 and 6, discloses the donor providing company gift matching information).

However, the DonationDepot.com fails to explicitly disclose receiving data from the employee; verifying the donation information; loyalty points being used as a donation to a charitable organization; and verifying donation information.

MacFarlane et al. discloses a gift matching method with the concept of receiving data from the employee indicating that the employer: will gift match at least a portion of the donation amount; and should be granted access rights to verify the donation information (Abstract, discloses receiving information indicating the gift matching amount being provided by the gift matcher);



Art Unit: 3689

verifying the donation information on behalf of the employer by, at least: confirming a payment from the employer for the donation amount was processed (Fig. 6A, discloses confirming a payment via confirming transfer has cleared); verifying that the charity selected by the employer is a government approved charity by, at least, searching at least one of an Internal Revenue Service (IRS) database and a third-party database of government approved charities (Col. 9, Lines 11-35, discloses determining whether the charity qualifies in the United States as a charity); and generating a receipt for the employer by, at least: searching gift matching forms specific to the employer; selecting a particular form based, at least in part, on the charity selected by the employee; completing the selected gift matching form specific to the employer based on the donation information; and forwarding the completed form to the employer; and activating, after the verifying, a gift matching payment on behalf of the employer (Col. 8, Line 50-67, discloses providing a tax receipt to a matching party wherein matching forms are selected and completed by initiators).

Therefore, from the teaching of MacFarlane et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system for conducting donations of DonationDepot.com to include receiving data from the employee and verifying the donation information as taught by MacFarlane et al. in order to aid provide a convenient means to donate to charitable organizations electronically.

Examiner asserts the fact that the employee submits donation information and the data received indicates that the employee will gift match and should be granted access rights in considered non-functional descriptive material. The person submitting

Art Unit: 3689

donation information being an employee and the type of data being received does not change the function of the claimed invention. Examiner asserts the DonationDepot.com and MacFarlane et al. combination is fully capable of the employee submitting donation information and the data received indicating that the employee will gift match and should be granted access rights in considered non-functional descriptive material.

Chien et al. discloses a system and method for using loyalty points with the concept of loyalty points being used as a charitable donation ([0012] discloses a user redeeming or converting loyalty points for charitable donations) wherein donation information is verified by communication with at least one third party, said third party including at least one of a financial institution, a charity, a loyalty point issuer, an employer, and a government entity authorized to approve charities ([0010-0011] discloses an account manager verifying loyalty point information via verifying that sufficient credit is available on participant's financial transaction account and/or sufficient loyalty points are available in participant's loyalty account).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the DonationDepot.com and MacFarlane combination to include loyalty points being used as a donation to a charitable organization and donation information is verified as taught by Chien et al. in order to provide a non-monetary way for a donor to contribute to a desired charitable organization.

***Response to Arguments***

7. Applicant's arguments filed October 24, 2008 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thur 7:30am-6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3689

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689